

09/877,835

6

P-5686U1-C1-1

REMARKS

Reconsideration of the present application and entry of the amendment is respectfully requested. Claims 1 to 9, 11 to 17, 19 and 20 are currently pending, and claim 11 has been amended.

The Final Office Action mailed March 10, 2004 addressed claims 1 to 9, 11 to 17, 19 and 20. Claims 1 to 9, 11 to 17, 19 and 20 were rejected.

Claims 11 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that claim 11 depends from claim 10, which has been canceled, and claim 19 depends from claim 11.

Claim 11 has been amended to correct the dependency and to depend from claim 1. Applicant respectfully submits that this overcomes the rejection and requests that the Examiner reconsider and withdraw the rejection of claims 11 and 19 under 35 U.S.C. § 112, second paragraph.

Claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Melvin et al. (US 5,779,562). The Advisory Action of June 29, 2004 stated that Yamagishi et al. (US 5,688,595) was inadvertently omitted from the rejection.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. Melvin et al. discloses a multi-core, multi-layer cover golf ball wherein the specific gravity of the inner core and the core layer are different by at least 0.1. Melvin et al. discloses that the moment of inertia of the ball can be controlled by changing the specific gravities of the inner core and core layer, depending on the desired moment of inertia. Melvin et al. does not disclose the hardness of the inner core, but Melvin et al. discloses that the outer cover layer is less than 55 Shore D and is also less than the inner core, and that the outer core has a Shore C of less than 80. Therefore, the inner core can be softer or harder than the core layer, as long as the specific requirements are met.

The Examiner stated that Yamagishi et al. "was not used to teach cover hardness, only the core relationship." Yamagishi discloses a golf ball having a soft inner core, a hard

09/877,835

7

P-5686U1-C1-1

core layer, and a soft cover wherein the inner cover layer is softer than the outer cover layer. The layers of Yamagishi's ball have specific properties to provide a specific feel and result. The cover layers of Yamagishi et al. are different from that of Melvin et al. because Melvin et al. has a hard inner cover layer and a soft outer cover layer, while Yamagishi et al. has a soft inner cover layer and a harder outer cover layer that is still fairly soft.

Applicant respectfully submits that even if Yamagishi et al. is combined with Melvin et al. in the rejection, there is no motivation, suggestion or teaching to substitute the core of Yamagishi et al. for the core of Melvin et al. because Melvin et al. discloses that the core has specific properties designed to control the moment of inertia, and Yamagishi et al. has a harder outer core layer because of the softer cover. At most, there might be a motivation to try the core of Yamagishi et al. in the golf ball of Melvin et al., but motivation to try is clearly not the standard. Applicant respectfully submits that the Examiner is picking and choosing elements to reconstruct Applicant's invention, and this is not allowed. The Examiner cannot choose a core from a ball having completely different properties and substitute it into another ball solely for the purpose of reconstructing Applicant's invention.

In the Response to Arguments, the Examiner states that 35 U.S.C. § 103 only requires motivation, not anticipation. Applicant agrees, but as previously stated, the Examiner has failed to provide even the motivation.

Additionally, as stated by the Examiner, Melvin discloses a cover layer where the inner cover is harder than the outer cover layer. Applicant respectfully submits that Melvin does not disclose the ranges as claimed by applicants in part (i) of claims 1, 14 and 20, nor does Melvin disclose the cover combinations disclosed in parts (ii), (iii) or (iv) of claims 1 and 14, or part (ii) of claim 20.

For at least these reasons, Applicant respectfully submits that the rejection of claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 1 to 3, 5 to 9, 11 to 16, 19 and 20 be reconsidered and withdrawn.

Claims 4 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Melvin et al. (US 5,779,562) in view of Yamagishi et al. (US 5,688,595) and further in view of Farrally et al. (Science and Golf III). The Examiner stated that Melvin et al. does

09/877,835

8

P-5686U1-C1-1

not disclose the outer core layer having two or more layers, but Farrally et al. discloses that having a core more than two layers is advantageous in distributing the weight and specific gravity of the golf ball. The Examiner concluded that one having ordinary skill in the art at the time the invention was made would have found it obvious to incorporate a core layer with two or more layers in order to optimize the weight distribution and specific gravity of the golf ball.

Applicant respectfully disagrees with the Examiner and submits that the Examiner has not made out a *prima facie* case of obviousness. As discussed above, Applicant respectfully submits that Melvin et al., either alone or in combination with Yamagishi et al. does not disclose Applicant's invention. The addition of Farrally et al. also does not disclose Applicant's invention. Additionally, Applicant respectfully submits that Farrally et al. (on page 411) discloses that double cores, not a core with two or more layers, are advantageous. Contrary to the assertions of the Examiner, the reference does not comment on the advantage or disadvantage of having a core with two or more layers. The reference merely states that 'Kasco now has a triple core named "Rockets"', but it makes no comment on the advantage or disadvantage of such a core. Farrally et al. provides no motivation, suggestion or teaching for a core with a center and two or more layers.

For at least these reasons, Applicant respectfully submits that the rejection of claims 4 and 17 under 35 U.S.C. § 103(a) has been overcome. Applicant therefore requests that the rejection of claims 4 and 17 be reconsidered and withdrawn.

The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

09/877,835

9

P-5686U1-C1-1

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 9, 11 to 17, 19 and 20. Applicant respectfully requests allowance of claims 1 to 9, 11 to 17, 19 and 20, the claims currently pending.

Respectfully submitted,

R. DENNIS NESBITT

Customer No. 24492
Phone: (413) 322-2937

Date: July 13, 2004

By: Michelle Bugbee
Michelle Bugbee, Reg. No. 42,370
The Top-Flite Golf Company
A wholly-owned subsidiary of Callaway Golf Company
Attorney for Applicant
425 Meadow Street
P.O. Box 901
Chicopee, MA 01021-0901

cc: Richard M. Klein, Esquire (SLDZ 2 0214-3)